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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/584,706 | 05/10/2007 | Hartmut S. Engel | LA-7690-103 | 3482 |
| 167 7590 03/14/2008 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071 | | | | |
| EXAMINER | | | | |
| SEMBER, THOMAS M | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2885 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,706

Applicant(s)

ENGEL, HARTMUT S.

Examiner

Thomas M. Sember

Art Unit

2885

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 09/27/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because no formal drawings were ever submitted with the application filed on 06/23/06. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-29, 32-36 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Perlo et al '282. Perlo et al '282 discloses a plurality of downlight reflectors 4 which are illuminated by an illuminant and which each have a front reflector

opening (see figure 6, near detail 4) disposed in the direction of illumination, wherein at least two downlight reflectors 4 can be illuminated by a common illuminant 1 via a respective rear reflector opening (see figure 6, near detail 12), wherein the front reflector openings (see figure 6, near detail 4) define direct light discharge regions (see figure 6, near detail 4), which are surrounded at least regionally by at least one diffuse (reflect) light discharge region 3, and wherein the diffuse (reflect) light discharge regions 3 can be illuminated directly by sections of the common illuminant 2 disposed outside the rear reflector openings.

Regarding claims 26-28 applicant claims that two downlight reflectors **can be** illuminated by a plurality of common illuminants and common illuminants have color shades different from one another. This language is merely intended use language and since the downlight reflector of Perlo et al '282 is capable of having a plurality of common illuminants having color shades different from one another, Perlo et al '282 meets claims 26-28.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-29 and 32-40 are rejected under 35 U.S.C. 102(b) as being anticipated by EP0359069. EP0359069 discloses a plurality of downlight reflectors 5 which are illuminated by an illuminant and which each have a front reflector opening (5a

or 5'a) disposed in the direction of illumination, wherein at least two downlight reflectors 5 can be illuminated by a common illuminant 2 via a respective rear reflector opening (5b or 5'b), wherein the front reflector openings (5a or 5'a) define direct light discharge regions (5b or 5'b), which are surrounded at least regionally by at least one diffuse light discharge region (5'), and wherein the diffuse light discharge regions (5') can be illuminated directly by sections of the common illuminant 2 disposed outside the rear reflector openings.

Regarding claims 26-28 applicant claims that two downlight reflectors **can be** illuminated by a plurality of common illuminants and common illuminants have color shades different from one another. This language is merely intended use language and since the downlight reflector of EP0359069 is capable of having a plurality of common illuminants having color shades different from one another, EP0359069 meets claims 26-28.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over (EP0359069 or Perlo et al '282) in view of (Littman et al '815 or Barclay '324). (EP0359069 or Perlo et al '282) discloses the claimed invention except for the teaching that the downlight fixtures are pivotally held in a housing. (Littman et al '815 or Barclay

'324 teaches downlight fixtures which are pivotally held in a housing. It would have been obvious to one skilled in the art at the time the invention was made to modify the downlight fixtures of (EP0359069 or Perlo et al '282) to be pivotable in a housing as taught by (Littman et al '815 or Barclay '324) in order to access the assembly or change the direction of illumination of the downlight fixtures of (EP0359069 or Perlo et al '282).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cerone et al '216, Bartenbach '099, Geissler '234, Holten et al '411 & '934 and Ladstatter '368 disclose lighting assemblies which is similar to applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is 571-272-2381. The examiner can normally be reached on M-F 9 a.m.- 5.30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong Suk (James) Lee can be reached on 571-272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas M Sember/
Primary Examiner, Art Unit 2885